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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,371	04/25/2001	Diane C. Breidenbach		6561

7590 01/30/2007
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EXAMINER

NGUYEN, TUAN N

ART UNIT	PAPER NUMBER
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3751

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/842,371

Applicant(s)

BREIDENBACH ET AL.

Examiner

Tuan N. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 and 51 is/are pending in the application.
- 4a) Of the above claim(s) 32-39 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 40-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1 and 42-50 have been considered but are moot in view of the new ground(s) of rejection.

Specification

2. The disclosure is objected to because of the following informalities: The continuation data in the first paragraph of page 1 needs to be filled out accordingly. Appropriate correction is required.

Claim Objections

3. Claims 8, 11-20, 27-31, 40 and 41 are objected to because of the following informalities: claim 1 has already claimed a doe foot applicator on line 12; therefore, claims 8, 11-20, 27-31, 40 and 41 are either redundant or inconsistent. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-31 and 40-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,897,626 (hereinafter Bratby-Carey) in view of US Patent 5,937,866 (hereinafter Magharehi) and US Patent 6,276,856 (hereinafter Pieper).

Bratby-Carey discloses a dual ended container (see Fig. 1) comprising a sleeve (44) that has first and second ends, each of the ends being adapted to receive a receptacle (12, 28) for containing a product, the receptacles is capable of containing any of the specific well known fluid products as claimed, wherein the product in the first receptacle could be different from the product in the second receptacle depend on the user wishes. The intended use with different product and all other functional phrases have been carefully considered but are deemed not to describe any structure patentably distinguishable over the device that disclosed by Bratby-Carey which is certainly capable of being used in the claimed manner. The sleeve (44) of Bratby-Carey has a first section and a second section, which are connected by a sidewall (see Fig. 2). The receptacle (12) has an applicator pad (24) for applying the fluid product in the receptacle and extending into one end of the sleeve and being removably connected to one end of the sleeve; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the applicator pad of Bratby-Carey with a rollerball applicator (39) of Magharehi, where in so doing would involve mere substitution of one functional equivalent applicator head for another and the selection of any of these known equivalents to apply a fluid onto a surface would perform equally well on the Bratby-Carey device. The second end of the sleeve (44) has a rod (58) extending therefrom, the rod has a brush (42) attached thereto instead of a doe foot; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the brush (42) applicator of Bratby-Carey with a doe foot applicator (56) of Pieper, where in so doing would involve mere substitution of one

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functional equivalent applicator head for another and the selection of any of these known equivalents to apply a fluid onto a surface would perform equally well on the Bratby-Carey device. The other claimed features such as the sidewall of the first receptacle is parallel to the sidewall of the second receptacle, the center axis, and the cross section shape are clearly shown and anticipated by Bratby-Carey. The brush of Bratby-Carey can be called "a mascara brush" since no structure is claimed to distinguish otherwise.

Conclusion

5. The affidavit under 37 CFR 1.132 filed 4/3/06 is insufficient to overcome the rejection of claims 1-31 and 40-50 based upon the evidence is not commensurate with the scope of the claims as set forth in the last Office action because: in order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features; other equivalent language does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product which has been sold corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims; there is no evidence showing the commercial success alleged is directly derived from the invention claimed; the applicant must show that the claimed features were responsible for the commercial success of an article; and evidence of commercial success must be clearly attributable to the design to be of probative value, and not to brand name recognition. In view of the


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foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan N. Nguyen whose telephone number is 571-272-4892. The examiner can normally be reached on Monday-Friday (10:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tuan Nguyen
Primary Examiner
Art Unit 3751

TN